

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In the Application of:	)	<b>Electronically Filed on</b>
Winslade, <i>et al.</i>	)	<b>April 27, 2011</b>
Serial No.: 09/687,499	)	Examiner: Retta, Yehdega
Filed: October 13, 2000	)	Group Art Unit: 3622
For: SYSTEM FOR ONLINE SALES	)	Confirmation No.: 1146
WITH AUTOMATIC REBATE AND	)	
COUPON REDEMPTION	)	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the final rejection in the above-identified application.  
No amendments are being filed with this request.

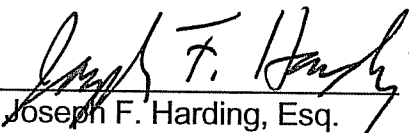
This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Date: April 27, 2011

By: \_\_\_\_\_

  
Joseph F. Harding, Esq.  
Reg. No. 48,450  
Attorney for Applicant

McANDREWS, HELD & MALLOY, LTD.  
500 West Madison Street, 34th Floor  
Chicago, Illinois 60661  
Telephone: (312) 775-8000  
Facsimile: (312) 775-8100

### REMARKS

The present application includes pending claims 34-39. (See 01/27/011 Office Action.) Claims 34 and 35 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,915,271 ("Meyer"). Claims 36-39 stand rejected under 35 U.S.C. §103(a) as unpatentable over Meyer in view of U.S. Patent Application Publication No. 2002/0052778 ("Murphy"). Claims 36 and 39 stand rejected under 35 U.S.C. §103(a) as unpatentable over Eichmann in view of U.S. Patent No. 5,729,693 ("Holda-Fleck").

The Office Action fails to demonstrate that the claims are anticipated, fails to present a *prima facie* showing of obviousness, and fails to establish that the cited references, either alone or in combination, render obvious the presently claimed subject matter, as also previously demonstrated by Applicants. (See, e.g., November 23, 2010 Response at p. 8-14.) As discussed previously and below, Applicants respectfully submit that the rejections are clearly in error, both factually and legally.

Applicants first address the rejection of claim 34 as being purportedly anticipated by Meyer. To anticipate, a single prior art reference must disclose each and every element as set forth in the claim. (See MPEP § 2131.) Further, the elements of the claim must be arranged as required by the claim. Applicants respectfully submit that Meyer does not disclose each and every element of the presently claimed subject matter in the required detail or arranged as required, and does not anticipate.

Applicants respectfully traverse the rejection as set forth by the Office Action, at least for similar reasons as discussed in previous submissions. Claim 34 recites, for example, "offering, by a second system of a second party, an item for sale online at a sales price amount, wherein the item for sale can be identified on the second system by a customer using the second system," and "providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion **after the customer has identified the item for sale on the second system...**" Thus, it is the second system that offers the item for sale and provides a portal wherein the customer can search for a promotion from the first party, **after** the customer has identified the item for sale on the second system.

The Office Action relies upon a purported teaching by Meyer of "offering by a second system of a second party (the service provider that runs the incentive system) items for sale at a sales price amount (items that are sold at the websites)..." (See Office Action at p. 2.) The Office Action states that it is not relying on "Target Holt EB, Amazon.com" as the second system, but instead, "...the second system which provides items for sale is now the service provider, which provides the incentive system (where the merchants (first entity distinct from the incentive system) are included." (See *id.* at p. 6.) The Office Action also relies upon "fig. 19-34, col. 45 lines 19-44" as purportedly teaching "wherein the customer can search for the promotion after the customer has identified the item for sale on the second system." (See *id.* at p. 2.) However, these figures (see, e.g. Fig. 30, 33) relate to the "Buy Now" feature, which directs the customer to a website for purchase *after* the incentive has been selected. The Office Action offers no explanation for how or why Meyer teaches such a search for an

incentive (or why a portal for such a search would be provided) after identifying an item for purchase, when it was the incentive itself from which the consumer was originally directed to the item for purchase in the first place. No such explanation is readily available, since Meyer clearly teaches the opposite of, and thus teaches away from, what is claimed.

Further, the Office Action asserts that “[t]he claim does not recite that the portal is provided after the item is selected or selected for sale. The claim recites wherein the customer can search for the promotion after the customer has identified the item for sale.” (See Office Action at p. 7.) The “wherein the customer can search...” clause, however, describes the providing of the portal. The claim plainly recites “**providing by the second system a portal...wherein the customer can search for the promotion after the customer has identified the item for sale.**” For the customer to search the portal after the customer has identified the item for sale, the portal must be provided after the item has been identified for sale.

Next, Applicants turn to the rejection of claim 35. Applicants respectfully traverse the rejection as set forth by the Office Action, at least for similar reasons as discussed in previous submissions. As also discussed in previous responses, Claim 35 recites, for example “offering, by a second system of a second party, an item for sale online at a sales price amount,” where the item for sale has associated with it by the second system of the second party “a promotion from the first party,” and further recites that “the second system is distinct from the first system and the second party is distinct from the first party.” Claim 35 also recites “causing, by the second system, **shipment by the second party...**” Thus claim 35 requires that the promotion is from a first party, and that a distinct second party, *inter alia*, offers the item for sale online, and ships the item.

The cited portions of Meyer, however, do not teach such a second system (as fully defined throughout the claim) causing shipment by a second party. For example, the Office Action cites to Meyer at 41:22-40 as teaching “causing, by the second system, shipment by the second party...”, yet this portion of Meyer merely teaches the “service provider” (the alleged second party/system) providing information to a vendor, not shipping. The Office Action attempts to justify such an assertion by stating, “The claim recites causing by the second system shipment of the item but **does not positively recite the second party shipping the item** (i.e., the item is directly shipped by the second system of the second party).” (See Office Action at p. 7.) This is directly contrary to the plain language of the claim: “causing, by the second system, **shipment by the second party** of the item for sale to the buyer.” Applicants respectfully submit such a rejection is clearly in error, factually and legally.

Claim 36 and its dependent claims stand rejected as being unpatentable over Meyer in view of various other references. As an initial matter, claim 36, similar to claim 35, expressly recites that the first party (which the promotion having a promotion amount is from) and the second party (which offers an item for sale online), as well as the first and second systems, are distinct. Further, the Office Action relies solely upon

Meyer as teaching the common aspects shared between claim 35 and claim 36. As discussed above and in previous submissions, Applicants respectfully submit that the additionally cited references do not remedy the above shortcomings in the disclosure of Meyer, and that claim 36 and its dependent claims are allowable for at least similar reasons as those discussed above with respect to claim 35 and in previous submissions.

In previous submissions, Applicants demonstrated the failure of the cited art to teach "...wherein the item has been acquired by the second party from the first party..." The Office Action first asserts that "it is unclear if applicant mean for the second party to physically obtain the item from the first party or to just have." (See Office Action at p. 7.) Applicants respectfully submit the claim plainly states that "the item has been acquired by the second party from the first party," which is different than "to just have." In any event, the Office Action relies upon the merchants in Meyer as the second party and "manufacturers" as the second party. (See *id.* at p. 7-8.) However, Applicants are unable to find any example, teaching, or suggestion in Meyer of a promotion from a manufacturer of goods, a separate and distinct vendor acquiring the goods from the manufacturer, and the vendor offering the goods for sale online, let alone the subject matter of claim 36 as fully set forth. Again, whether or not vendors acquire products from manufacturers cannot be stretched so far as to teach, suggest, or otherwise render obvious a promotion from a first party having a first system, and a distinct second system of a distinct second party offering an item for sale online that has been acquired by the second party from the first party, with the item for sale having associated with it a promotion from the first party.

Further still, without conceding that Murphy qualifies as prior art, Applicants respectfully submit that neither Murphy nor Holda-Fleck remedy the shortcomings of Meyer. For example, the purported "service fee" of Murphy is not collected by a second system (that offers the item for sale online) as required by the claims. Instead, in Murphy, the "\$50 fee" is collected by a website operator, but the incentive is used when buying a product neither purchased from the website operator, nor even purchased online, as Murphy discusses an automobile purchase at a dealership. (See Murphy at [0018].) Further still, claim 38 recites "wherein a first amount is defined by the sales price less the promotion amount, and the purchase amount collected from the buyer equals the first amount plus the service fee." In Murphy, the website operator merely collects only the "\$50 fee." Applicants respectfully submit such a disclosure does not teach, suggest, or otherwise render obvious "wherein a first amount is defined by the sales price less the promotion amount, and the purchase amount collected from the buyer equals the first amount plus the service fee."

With respect to the rejection of claims 36 and 39 as allegedly obvious under Meyer in view of Holda-Fleck, Applicants note that the cited portion of Holda-Fleck relates to collection of a service charge by a telephone service provider, which, again, does not offer items for sale online or collect a purchase amount. Indeed, in the cited portion of Holda-Fleck, the item has already been purchased before the telephone

service is accessed. (See Holda-Fleck at 3:3-32.) In contrast, in claim 36, it is the second system of the second party that offers an item for sale online, collects a purchase amount, and collects a service fee. Thus, the service charge in Holda-Fleck is not collected by the "second party" as set forth in the claim 36. Further still, the service fee in claim 36 is "associated with an online purchase request." Applicants respectfully submit that the service provider of the cited portion of Holda-Fleck - which is not accessed until after an item is purchased - cannot teach, suggest, or otherwise render obvious collecting a service fee **associated with an online purchase request**.

For at least the above discussed reasons, in addition to those discussed in previous submissions, Applicants respectfully submit that the Office Action fails to demonstrate that the claims are anticipated and/or rendered obvious, and fails to present a *prima facie* showing of obviousness. Applicants respectfully submit that the rejections are clearly in error, both factually and legally, and respectfully requests that the rejections be withdrawn and the application passed to issuance.

The Commissioner is authorized to charge any necessary fees, including the fees for the Notice of Appeal, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.